

09/364,522

MS136622.1

REMARKS

Claims 1-43 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1, 8-12, 22-25, 26-27, 30-33, 35, and 41-43

Under 35 U.S.C. § 103(a)

Claims 1, 8-12, 22-25, 26-27, 30-33, 35, 41-43 stand rejected under 35 U.S.C. §103(a) as being obvious over Lewis, "Evaluating and Optimizing Autonomous Text Classification Systems", 1995 ACM. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Lewis does not teach or suggest applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

Independent claim 1 recites generating *priority* of a document based on a document classifier. Contrary to assertions made in the Office Action, such aspects of applicants' claimed invention are not taught or suggested by Lewis. [Rather, Lewis teaches a method that continuously *evaluates effectiveness* of a text classifier to *optimize* performance thereof. Lewis defines an effectiveness measure that is applied to a set of decisions, followed by the system continuously estimating of such effectiveness.]

The teachings of Lewis to simply *optimize* a binary text classification system do not

09/364,522

MS136622.1

make obvious applicants' invention, as recited in the subject claims. The claimed invention, for example can be employed to *prioritize* documents (e.g., e-mail) as well as generate an urgency value (e.g., given state of user, determined priority of document, predetermined thresholds...) as recited in various dependent claims of the subject application. More particularly, the claimed invention provides for training classifiers to directly classify incoming content with a *priority* that can be employed to sort, alert, etc. A classifier in accordance with the subject invention can then directly determine urgency of communications, e.g. a determined urgency score can be a measure of "expected cost of delayed review" that can be weighed against cost of disruption, so as to provide a means for balancing costs and benefits of alerting a user. The score can also be used in an ambient display to list documents in order of priority, and perform functions such as automated opening and/or alerting in connection with the documents as well as relaying of documents based on priority.

Despite the lack of teaching or suggestion of applicants' claimed invention in Lewis, the Examiner rejects the subject claims by asserting that it is obvious to modify Lewis to achieve benefits identified in applicants' specification. Applicants' representative respectfully submits that obviousness cannot be established absent some teaching or suggestion supporting the modification.

That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the references in such a manner as to arrive at the claimed invention... [I]t would not have been obvious to modify [the prior art] ... without using [the patent application's] claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." *Ex parte Hiyamizu*, 10 USPQ2d 1393 (BPAI 1988).

Here, neither the nature of the problem to be solved, teachings or suggestions of Lewis, nor the knowledge of a person of ordinary skill provide sufficient suggestion or motivation to modify Lewis. In fact, the term "*priority* (-ize, -ization, ... etc.)" *does not appear* in any section of Lewis - even in the section entitled "*future work*", which outlines desired research areas in nature of the problem and possible modifications of Lewis. (See

09/364,522

MS136622.1

Lewis at page 251.)

In view of at least the above, it is respectfully submitted that Lewis does not teach or suggest applicants' claimed invention as recited in independent claims 1, and 26, and claims 8-12, and 27, 30-33, 35, 41-43 which respectively depend there from, and claims 22-25 that depend from independent claim 19.

II. Rejection of Claims 2, 19-20, and 34 Under 35 U.S.C. § 103(a)

Claims 2, 19-20, and 34 stand rejected under 35 U.S.C. §103(a) as being obvious over Lewis, in view of Cohen, "Learning Rules that Classify E-Mail", 1996 (as disclosed at <http://www-2.cs.cmu.edu/~wcohen/pubs-t.html>).

It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Lewis nor Cohen, alone or in combination, teach or suggest applicants' claimed invention let alone there being no motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

As discussed *supra* with respect to independent claims 1, 19 and 26 Lewis does not teach or suggest applicants' invention as recited in subject claims. In addition, Cohen merely relates to using classifiers in connection with categorizing e-mails *via keyword-spotting rulesets* so as to place respective e-mails in proper folders, and does not make up for the aforementioned deficiencies of Lewis with respect to the subject independent claims.

In view of at least the above, it is respectfully submitted that the combination of Lewis and Cohen do not teach or make obvious the subject invention as recited in claim 2 (which depends from independent claim 1), independent claim 19 and claim 20 dependent therefrom, and claim 34 that depends from independent claim 26. Accordingly, this rejection should be withdrawn.

09/364,522

MS136622.1

III. Rejection of Claims 3-7, 21, 28-29, and 37-40 Under 35 U.S.C. § 103(a)

Claims 3-7, 21, 28-29, and 37-40 stand rejected under 35 U.S.C. §103(a) as being obvious over Lewis, as applied to claims 1, 19, and 26 above, in view of Henderson *et al.*, (US Patent 6,185,603.) Withdrawal of this rejection is respectfully requested for at least the following reasons.

As discussed *supra* with respect to independent claims 1, 19 and 26, Lewis does not teach or make obvious the subject invention as recited in these claims. The subject claims respectively depend from these independent claims. Henderson *et al.* does not make up for the aforementioned deficiencies of Lewis, in regards to the subject independent claims. Accordingly, this rejection should be withdrawn.

IV. Rejection of Claims 13-18 and 36 Under 35 U.S.C. § 103(a)

Claims 13-18 and 36 stand rejected under 35 U.S.C. §103(a) as being obvious over Lewis, in view of Cohen and Platt (US Patent 6,327,581).

Independent claim 13 recites similar limitations as discussed *supra* with respect to claims 1, 19 and 26. Accordingly, the aforementioned deficiencies of Lewis and Cohen apply to this claim as well, and Platt does not make up for the above-noted deficiencies. Moreover, it is noted that claim 13 recites a Bayesian classifier, and Cohen teaches away from employment of such type of classifier – “[I]t should be noted that these rulesets are quite different from the classifiers constructed by more common text categorization learning methods, such as naïve Bayes...” (see page 1, col. 2 of Cohen). A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In addition, claim 36 depends from independent claim 26, and Platt and Cohen do not make up for the above-noted deficiencies of Lewis with respect to claim 26. In view of at least the above, this rejection should be withdrawn.

09/364,522

MS136622.1

V. CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

The Commissioner is authorized to charge the fee of \$110.00 for the one month extension of time to Deposit Account No. 50-1063, Order No. MSFTP272US.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731